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10/804,252	03/19/2004	Peter Polick	401-205	7492
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HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
			EXAMINER WILLIAMS, JAMILA O	
			ART UNIT 3722	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/804,252

Applicant(s)

POLICK, PETER

Examiner

Jamila Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-19,21,22,26,27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-19,21-22,26-27,29-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The indication of allowable subject matter in the office action of November 8, 2006 has been withdrawn in light of the rejections below. The examiner apologizes for the delay in prosecution.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-19,21,22,26,27,29,30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 5 what is unclear what is encompassed by the phrase "one half of a first whole sheet...one half of a second whole sheet".

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,3,6-10,12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by 3,055,118 to Betancourt.

Betancourt discloses a book containing at least one removable panel (24) and at least one pocket-containing leaf (12) having a front and back wall. The front wall of the pocket comprising an outer surface comprising a first page and the back wall

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comprising an outer surface comprising a second page, wherein at least one of the pages comprises predefined indicia (fig 1, see image 14 for example) and at least one aperture (18). The panel (24) comprises at least one panel indicia field (area where indicia 30 is printed constitutes an indicia field) and the at least one aperture is positioned in aligned relation to one of the panel indicia fields when the panel is inserted into the pocket (see figure 4), wherein the front wall comprises one half of a first whole sheet and the back wall comprises one half of a second whole sheet (as best understood in light of the 112 rejection above, the examiner takes the position that the pocket of Betancourt meets this limitation) as recited in claim 1. The front and back walls being fastened to one another along reciprocal, facing perimeter sections of front and back walls (fig 1), as recited in claim 3.

Regarding claim 6, Betancourt discloses panel indicia disposed within at least one of the indicia fields (30).

Regarding claim 7, wherein the panel that is adapted to receive user-created panel indicia within the indicia field, the panel of Betancourt is inherently capable of receiving user created indicia thereon.

Regarding claim 8, Betancourt discloses that the panel comprises categorical indicia (Lesson 2, for example).

Regarding claims 9-10, Betancourt discloses the panel having a tabular section (26) comprising tabular indicia (English) that relates to a common theme.

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Regarding claim 12, Betancourt discloses a second half of the first whole sheet operates as a front cover and a second half of a sheet operates as a back cover (as best understood, see sheets 12 operating as front and back covers.)

Regarding claim 13, Betancourt discloses further comprising a first pocket containing leaf and a last pocket containing leaf (see pockets formed by 12).

Regarding claim 14, see rejection of claim 12 above.

3. Claims 1,3-5,6,7,15-18,21,22,26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by 5,141,253 to Rice.

Rice discloses a book containing at least one removable panel (41, in that the sheets 21 and 51 are not sealed along the top edge, the panel 41 is capable of being removed see figures 6-7) and at least one pocket containing leaf (formed by sheet 21 and 51). The front wall of the pocket comprising an outer surface comprising a first sheet and the back wall of the pocket comprising a second sheet (figs. 2 and 5). Rice discloses having predetermined indicia on at least one of the pages (see fig. 3) and at least one aperture (53), wherein the panel comprises at least one panel indicia field (areas where indicia 45 is located makes up an indicia field) and the aperture (53) is positioned in aligned relation to one of the panel indicia fields when inserted into the pocket (figs 3-4), wherein the front wall comprises one half of a first whole sheet and the back wall comprises one half of a second whole sheet (as best understood in light of the 112 rejection above, the examiner takes the position that the pocket of Betancourt meets this limitation)as recited in claim 1.

Regarding claims 3-4, Rice discloses the front and back walls (21,51) are fastened directly to one another along reciprocal facing perimeter sections of the front and back walls (fig 5) and a spacer (64) is disposed between the front and back walls (fig 5 and col. 8 lines 45-68 of the specification).

Regarding claim 5 see rejections of claims 1 and 4 above.

Regarding claim 6, the panel (41) comprises panel indicia disposed within at least one of the indicia fields (indicia 45).

Regarding claim 7, the panel of Rice is inherently capable of receiving user-created panel indicia within at least one of the indicia fields.

Regarding claim 15, Rice discloses a separate cover (cover of publication 11), the second half of the first whole sheet and second half of the second whole sheet are bound to an inside of the front and back portion of the cover (all bound along the spine which is inside the cover).

Regarding claim 16, see rejection of claim 15 above.

Regarding claim 17, Rice discloses further comprising at least one double gatefold comprising a whole sheet folded into quarter sections, the whole sheet comprising a first section (61 that operates as a gatefold via perforations 62-63), a second section (21), a third section (41) and a fourth section (51 that operates as a gatefold via perforation 52).

Regarding claim 18, Rice discloses at least one single gatefold comprising a whole sheet folded into thirds, the whole sheet comprising first section (61 that operates as a gatefold via perforations 62-63), second section (21) and third section (41).

Regarding claims 21-22 and 26-27, Rice discloses that the at least one page and panel indicia comprises story-based predetermined indicia and indicia relating to educational categories (in that the indicia of Rice tells a story and educates the user about a product, this indicia satisfies the requirement of being story based or relating to an educational category- i.e. English or reading).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Betancourt in view of 2,944,356 to Anthon. Betancourt all of the elements of the claims as applied to claim 1 above. Betancourt does not however disclose having a spacer between the front and back walls of the pocket. Anthon teaches having a spacer the sheets of a pocket (col. 2 line 72 and col. 3 lines 1-7 of the specification). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the spacer of Anthon with the pocket of Betancourt for the purpose of spacing the sheets of the pocket such that the panels can be easier inserted and removed therefrom.
6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rice in view of 6,244,628 to Muller. Rice discloses all of the elements of the claims

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including having a tabular portion on the panel (see tab 34). Rice does not however disclose having indicia on the tab and the indicia on the tab and panel related to a common theme. Muller teaches having tabs (100) with indicia thereon. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaches of Muller to place indicia on a tab with the tab of Rice for the purpose of providing information to the user.

Rice modified by Muller discloses the claimed (tabs and panels with indicia) invention except for the specific arrangement and/or content of indicia (printed matter: common theme indicia as recited in claim 10) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the book comprising at least one panel, pocket and tab is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. book) which is required for patentability.



Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice in view of 2,438,048 to Graham or 893,353 to McGill. Rice discloses all of the elements of the claims including having a spacer (64). Rice does not however disclose having a locking mechanism capable of securing the panel in the pocket. Both Graham and McGill teach having locking mechanisms (fig 1 to McGill and fig 3 to Graham show clips that attach to sheets for securing them into position- this satisfies the locking mechanism of applicant- to the degree claimed). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the locking mechanism of either McGill or Graham with the spacer of Rice for the purpose of securing the panel in the pocket.
8. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rice or Betancourt in view of 5,951,298 to Werzberger. Both Rice and Betancourt disclose all of the elements of the claims as applied to claim 1 above. Neither of these references however disclose having a closing means on the aperture. Werzberger teaches having closing means (flaps 22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the closing means of Werberger with the apertures of Rice or Betancourt for the purpose of selectively displaying the indicia.

9. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Betancourt in view of Anthon and further in view of 1,099,188 to Mealand.

Betancourt as modified by Anthon discloses all elements of the claims as applied to claim 4 above. This combination does not however disclose a method of populating indicia fields with user-defined indicia without reference to the predefined indicia and inserting the panel comprising the user populated indicia into the pocket. Mealand teaches having indicia fields that can be populated with user-defined indicia (in blank spaces 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use this teaching by Mealand with the panels of Betancourt (as modified by Anthon) for the purpose of allowing the user to vary the lesson or story in the book.

10. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,540,260 to Tan in view of 5,947,522 to Boehm.

Tan discloses a book (photo album) comprising at least one removable panel (photo) and at least one pocket containing leaf (figure 7 of Tan). The pocket containing leaf comprising a front and back wall (front wall formed by half of sheet 64 see figures 3 and 8 and the back wall is formed by half of sheet 58 see figures 6 and 8 of Tan) to thereby form a pocket disposed between the front and back wall (figure 8 of Tan), the pocket adapted to removably receive the panel (figure 8 and column 2 lines 1-3 of Tan). The front wall comprising the outer surface of a first page and the back wall comprising an outer surface of a second page (figures 7-8 of Tan), at least one of the pages comprise at least one aperture (figure 3 and 7, sheet 64 of Tan), the removable panel

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comprising at least one panel indicia field (the image on the photograph would inherently provide an image indicia field), the aperture is positioned in aligned relation to the panel indicia field when the panel is inserted into the pocket. The front wall comprises one half of the first whole sheet and the back wall comprises one half of a second whole sheet (front wall formed by half of sheet 64 see figures 3 and 8 and the back wall is formed by half of sheet 58 see figures 6 and 8 of Tan, as best understood). Tan does not however disclose having predefined indicia on at least one of the pages.

Boehm teaches having an album page with predefined indicia (figures 5a,b for example of Boehm). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the predefined indicia of Boehm with the page of Tan for the purpose of providing a theme or information about the photograph.

Regarding claim 5, wherein the pocket further comprises a spacer disposed between the front and back walls (see figure 8 of Tan, the glue 70 provides some degree of space between the front and back walls therefore satisfying the recitation of a spacer).

### ***Response to Arguments***

The amendments to the specification and drawings overcome the rejections in the previous office action.

Upon further consideration the recitation of "one half of a first whole sheet...one half of a second whole sheet" is being held as indefinite since it is not clear what is included/excluded from this limitation. As best understood, the pockets of Betancourt and Rice meet this limitation.

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Tan in view of Boehm is also being applied as best understood for the recitation above.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 4-17-2007



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